

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:  
DARIUS J. PREISLER

Serial No.: 09/620,581

Group Art Unit: 2167

Filed: July 20, 2000

Examiner: C. Buchanan

For: OCCUPANT PROTECTION SYSTEM  
FOR VEHICLE WITH AIR BAG

Attorney Docket No.: VEI 0319 PUS

APPEAL BRIEF

Box AF  
Commissioner for Patents  
United States Patent and Trademark Office  
Washington, D.C. 20231

Sir:

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This is an appeal brief from the final rejection of claims 1 and 4-6 of the Office Action dated March 27, 2002. This application was filed on July 20, 2000.

I. REAL PARTY IN INTEREST


The real party in interest is Patent Holding Company, a corporation organized and existing under the laws of the state of Michigan, and having a place of business at 3662 James J. Pompo, Fraser, Michigan 48026, as set forth in the assignment recorded in the U.S. Patent and Trademark Office on July 20, 2000 at Reel 010955/Frame 0353.

## CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8

I hereby certify that this paper, including all enclosures referred to herein, is being deposited with the United States Postal Service as first-class mail, postage pre-paid, in an envelope addressed to: Box AF, Commissioner for Patents, United States Patent and Trademark Office, Washington, D.C. 20231 on:

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## **II. RELATED APPEALS AND INTERFERENCES**

There are no appeals or interferences related to the present appeal.

## **III. STATUS OF CLAIMS**

This application was filed on July 20, 2000. The application included claims 1-4 as filed. Claims 2 and 3 were canceled and claims 5 and 6 were added by an Amendment filed November 21, 2001. Claims 1 and 4-6 were finally rejected and are the subject of this appeal. The claims that are the subject matter of this appeal are reproduced in Appendix A.

## **IV. STATUS OF AMENDMENTS**

The Amendment filed on April 18, 2002 was not entered.

## **V. SUMMARY OF THE INVENTION**

The invention provides an occupant protection system for deploying a deployable air bag from a concealed location in a vehicle instrument panel having an opening. The protection system includes an air bag normally containable in a deflated condition adjacent the opening and deployable through the opening as a protection for the occupant. The air bag has a skin and a portion of that skin closes the opening when the air bag is deflated and remains as a portion of the air bag after the air bag is deployed.

The invention also provides in combination, a vehicle having an air bag deployable upon vehicle impact and an occupant protection system for deploying a deployable air bag from a concealed location in a vehicle instrument panel having an opening. The protection system includes an air bag normally containable in a deflated condition adjacent the opening and deployable upon vehicle impact through the opening as a protection for the occupant. The air bag has a skin and a portion of that skin closes the opening when the air bag is deflated and remains as a portion of the air bag after the air bag is deployed.

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The invention further provides the system and combination described above wherein the skin that closes the opening is flush with the vehicle instrument panel.

#### **VI. ISSUES**

1. Claims 1 and 4-6 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Madrigal et al. in view of Ward et al. The issue is whether the Examiner properly rejected the claims under Madrigal et al. in view of Ward et al.

#### **VII. GROUPING OF CLAIMS**

Claims 1 and 4 are the independent claims involved in the appeal. Dependent claims 5 and 6 are separately distinct from their respective independent claims and are therefore additionally argued separately and stand separately.

#### **VIII. ARGUMENT**

1. **The Examiner improperly rejected claims 1 and 4-6 under 35 U.S.C. § 103(a) as being unpatentable over Madrigal et al. in view of Ward et al.**

The Examiner rejected claims 1 through 4 under 35 U.S.C. § 103(a) as being unpatentable over Madrigal et al. (USPN 5,521,377) in view of Ward et al. (5,480,183).

Independent claims 1 and 4 include the limitation that "the air bag ha[s] a skin and a portion of that skin closes the opening . . . ." Neither Madrigal nor Ward disclose an air bag having a skin and a portion of that skin that closes the opening. Ward discloses and requires a door 26 for closing the opening. See, Ward, Figure 1 below.

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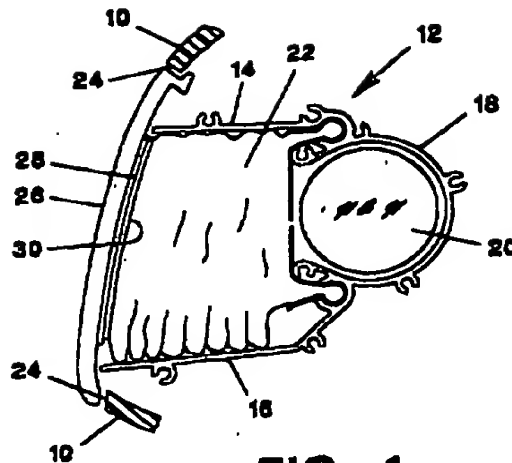


FIG. 1

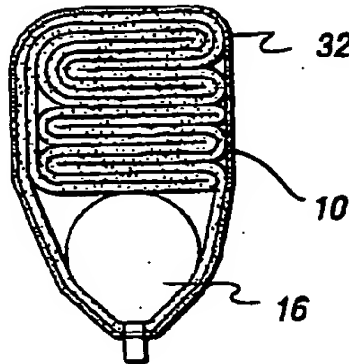
In fact, claim 1, the only independent claim in Ward, requires "a door ... forming a portion of the interior trim of said vehicle but openable under the influence of the expanding airbag ... and means for ... restraining motion of said door during such inflation ... wherein said securing and restraining means comprises: a pressure-sensitive material interconnecting said airbag and door whereby the folded air bag maintains said door in its closed position ...." Ward further claims that the pressure-sensitive material are "sheet-like" members (claim 2) and "hook and loop tear-apart fasteners" (claim 3). As evidenced by its inclusion into the independent claim, the door is a critical feature of Ward.

Madrigal discloses a perforated paper cover 32 which encloses the folded air bag 10 and inflator 16. See, Madrigal, column 3, lines 48-49 and Figure 17 reproduced

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below. Madrigal does not disclose any relationship between the air bag and an instrument panel.



Both prior art patents disclose covers or doors that cover the air bag. The combination of Madrigal and Ward therefore cannot be the basis for a 103(a) rejection because a claimed, material limitation, *i.e.*, that the air bag has a skin and a portion of that skin closes the opening, is absent from the prior art. *In re Fine*, 837 F.2d 1071, 1075-76, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988). The prior art simply does not teach, suggest, or disclose each and every element as set forth in the claims. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Further, the cover of Madrigal could not be removed without improperly destroying the intended function of the invention disclosed therein and therefore, the combination of art is improper. *In re Golden*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). In Madrigal, "the paper cover 32 ... encloses the folded airbag 10." Madrigal, col. 3, lines 48-49. Without the cover, the air bag would not stay folded and function as claimed.

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Additionally, the door of Ward could not be removed without improperly destroying the intended function of the invention disclosed therein and therefore, the combination of art is improper. *In re Golden*, 733 F.2d 900, 221USPQ 1125 (Fed. Cir. 1984). Ward specifically claims a door connected to the air bag in its claims. Without the door, the invention would not function as intended because a material element of the invention would be missing. Ward requires the door to close the opening in the instrument panel.

In the Claim Rejections section of the Final Office Action mailed March 27, 2002, the Examiner stated that it would be obvious "to modify the occupant protection system of Madrigal to include an airbag stored near and deployed through an opening in the instrument panel and a cover that is flush with the panel, as taught by Ward, to provide an airbag system with a cover that does not need to be attached to the airbag module." (emphasis added.) In the Response to Arguments section of the Final Office Action, the Examiner stated "it would be obvious to one skilled in the art that the location of the cover relative to the instrument panel could be varied as required by design." (emphasis added.) The Examiner fails to properly grasp the invention. There is no cover on the present invention as there is in Madrigal (paper cover 32) or Ward (cover 26). Rather, it is the air bag itself that closes the opening.

Further, there is no suggestion to modify either Madrigal or Ward by removing the covers and doors required by both inventions. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching, suggestion, or incentive that supports the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). As described above, the covers and doors are critical features in both Madrigal and Ward and both inventions would not be able to function as intended without the doors and covers present. There is no incentive to modify the prior art by removing critical features from the prior art. The Examiner has not provided the required particular findings supporting the Examiner's suggestion to modify the prior art by eliminating the cover and door. *In re Kotzab*, 217 F.3d